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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,047	12/20/2000	Steve Okun	11271STUS01U	9953

7590 12/16/2005

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EXAMINER	
MILLER, BRANDON J	
ART UNIT	PAPER NUMBER
2683	

DATE MAILED: 12/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/742,047	OKUN ET AL.	
	Examiner	Art Unit	
	Brandon J. Miller	2683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 November 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *25-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *25-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 December 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/28/2005 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cannon in view of Crockett and Forlenza.

Regarding claim 25 Cannon teaches a mobile station comprising: communication circuitry for processing wireless communication signals (see col. 2, lines 11-19). Cannon teaches audio processing circuitry for converting between sound and audio signal and for receiving sound from a microphone and for producing sound to a speaker (see col. 3, lines 11-19 and col. 4, lines 32-36 & 64-67). Cannon teaches logic to prompt the mobile station to generate signaling to a communication network element to complete call setup including completing connection of a voice channel and further to mute the microphone even though an incoming call

is connected (see col. 2, lines 21-29 & 51-65). Cannon teaches logic circuitry for prompting the mobile station to transmit a request to play a specified message to the calling party to advise the calling party that it is being placed on hold and that the called party will be taking the call shortly (see col. 2, lines 33-40). Cannon teaches wherein the mobile station only transmits the request if the called party depressed a select button or key while being alerted that a call was coming in for the called party (see col. 2, lines 30-40). Cannon does not specifically mention prompting a called party to take the call after a specified period of time as a reminder that a calling party is on hold and transmitting a request to a mobile switching center to further prompt an interactive voice response system to play a message. Crocket teaches prompting a called party to take the call after a specified period of time as a reminder that a calling party is on hold (see col. 6, lines 30-34 & 47-52). Forlenza teaches an interactive voice response system that plays a message (see col. 1, lines 45-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include prompting a called party to take the call after a specified period of time as a reminder that a calling party is on hold and transmitting a request to a mobile switching center to further prompt an interactive voice response system to play a message because a reminder can be generated while the voice channel is connected and an interactive voice response system can provide messages to a calling party, allowing for improved indication of call connection status.

Regarding claim 27 Cannon teaches a select button that is a keypad number button (see col. 2, lines 29-31).

Claims 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cannon in view of Crockett.

Regarding claim 28 Cannon teaches a mobile station comprising: communication circuitry for processing wireless communication signals (see col. 2, lines 11-19). Cannon teaches audio processing circuitry for converting between sound and audio signal and for receiving sound from a microphone and for producing sound to a speaker (see col. 3, lines 11-19 and col. 4, lines 32-36 & 64-67). Cannon teaches logic circuitry for prompting the mobile station to complete call connection including the voice channel and further to mute the microphone until the called party takes the call to prevent audio transmission over the connection call until the called party takes the call (see col. 2, lines 21-29 & 51-65). Cannon teaches transmitting a message to the calling party to advise the calling party that the called party will be taking the call shortly (see col. 2, lines 33-40). Cannon does not specifically mention prompting a called party to take the call after a specified period of time has elapsed as a reminder that a calling party is on hold. Crockett teaches completing connection of a voice channel (see col. 4, lines 15-19 and col. 5, lines 55-58). Crocket teaches prompting a called party to take the call after a specified period of time has elapsed as a reminder that a calling party is on hold (see col. 6, lines 30-34 & 47-52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include prompting a called party to take the call after a specified period of time has elapsed as a reminder that a calling party is on hold because a reminder can be generated while the voice channel is connected and this would allow for improved indication of call connection status.

Regarding claim 29 Cannon teaches a mobile station wherein the message is only transmitted if the called party depressed a select button or key while being alerted that a call was coming in for the called party (see col. 4, lines 3-14).

Regarding claim 30 Cannon teaches a microphone that is muted until the called party depresses a select key indicating that he is ready to take the call (see col.2, lines 51-65).

Regarding claim 31 Cannon teaches a speaker that is muted until the called party depresses a select key indicating that he is ready to take the call (see col.2, lines 51-65).

Claims 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chow in view of Forlenza.

Regarding claim 32 Chow teaches a method for connecting a call placed by a calling party to a called party having a multi-line capable phone (see col. 7, lines 21-26 and col. 72, lines 11-24). Chow teaches receiving an indication that a call is to be setup with the called party and determining a service node for the called party and transmitting call setup signals to the serving node (see col. 22, lines 11-13 & 49-67 and col. 23, lines 1-3). Chow teaches receiving an indication of the called party number (see col. 5, lines 29-33). Chow teaches connecting a first call to the called party (see col. 7, lines 21-26). Chow teaches receiving an indication from the called party to place the calling party on hold (see col. 73, lines 54-59 and col. 74, lines 35-40). Chow teaches responding to a called party response by triggering the play of a select message to the calling party to advise the calling party that the called party will be taking the call shortly (see col. 34, lines 50-61). Chow teaches when a specified period of time has elapsed, prompting a subsequent action (see col. 38, lines 5-9). Chow does not specifically teach an interactive voice response (IVR) to play a specified message. Forlenza teaches using an IVR for specified messages in call holding features (see col. 1, lines 45-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include an interactive voice response (IVR) to play a specified message because an interactive voice

response system can provide messages to a calling party and this would allow for improved methods of transmitting a signal indicating a call has been placed on hold.

Regarding claim 33 Chow teaches providing instructions to the calling party to give directions for leaving a message to get off hold (see col. 42, lines 5-11 & 22-30).

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chow in view of Forlenza and Crockett.

Regarding claim 34 Chow and Forlenza teach a device as recited in claim 32 except for providing a reminder to a called party that a second call is still on hold. Crockett teaches notifying a called party that a calling party has remained on hold (see col. 6, lines 30-34 & 47-52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include providing a reminder to a called party that a second call is still on hold because this would allow for improved communication control when a calling party has been placed on hold.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cannon in view of Crockett, Forlenza, and Chow.

Regarding claim 26 Cannon, Crockett, and Forlenza teach a device as recited in claim 25 except for prompting the mobile station to transmit an indication that the called party is ready to take the call. Cannon does teach a user of a mobile station that decides to take a call on hold by terminating the hold-state (see col. 3, lines 65-67). Chow teaches prompting the mobile station to transmit an indication that the called party is ready to take the call (see col. 42, lines 53-56). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include prompting the mobile station to transmit an indication that the

called party is ready to take the call because this would allow for efficient and effective processing of call waiting features.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 33 and 34 recite the limitation "the further action" in the first line of each claim. There is insufficient antecedent basis for this limitation in the claim.

Response to Arguments

Applicant's arguments filed 11/28/2005, have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, regarding claims 25-31 Cannon, Crockett and Forlenza all relate to call connection status and status indicators. An interactive voice response (IVR) can be used to play the specified message to the calling party in Cannon and because the voice channel is connected, a reminder can be made to the called party that a calling party is on hold. This would prove useful to a preoccupied called party such as the one mentioned in Cannon.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding claims 32-34, applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gutzmann U.S Patent No. 6,118,861 discloses a calling party invoked held call monitoring.

Nakamura U.S Patent No. 6,553,221 discloses incoming call notification apparatus.

Nguyen U.S. Patent No. 5,995,848 discloses a system and method of completing calls to busy mobile subscribers in a radio telecommunications network.

Ahlberg U.S. Patent No. 5,657,372 discloses systems and methods for selectively accepting telephone calls without establishing voice communications.

Burg U.S Patent No. 6,219,413 B1 discloses an apparatus and method for called-party telephone messaging while interconnected to a data network.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon J. Miller whose telephone number is 571-272-7869. The examiner can normally be reached on Mon.-Fri. 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

December 8, 2005

WILLIAM TROST
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